



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/883,463	06/15/2001	Rajendra Kumar	1386-D-CONT(3)-CIP-CONT	3125

27542 7590 04/28/2004

SAND & SEBOLT
AEGIS TOWER, SUITE 1100
4940 MUNSON STREET, NW
CANTON, OH 44718-3615

EXAMINER

ZIMMERMAN, BRIAN A

ART UNIT	PAPER NUMBER
----------	--------------

2635

DATE MAILED: 04/28/2004

4

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/883,463

Applicant(s)

KUMAR, RAJENDRA

Examiner

Brian A Zimmerman

Art Unit

2635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 2635

DETAILED ACTION

The information disclosure statement filed 2/12/02 has been received. It has been placed in the application file and has been considered as to the merits.

The amendment to the claims filed on 1/24/02 does not comply with the requirements of 37 CFR 1.121(c) because it presented claims numbered 18-24 and claims 18 and 19 already existed in the application. Claims 18-24 have been entered as renumbered claims 20-26.

Claim Objections

1. Claims 1,2 and 13 are objected to because of the following informalities: the term "shirt porket" needs to be changed to "shirt pocket" in order to correct the typographical error. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 3 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The

Art Unit: 2635

specification as originally filed does not provide support for having a housing of a portable handheld organizer that has two components that are movable between open and closed positions. The specification does support having the housing of the portable station in communication with the handheld device that includes the claimed housing limitations however this is not supporting of the handheld device having such a housing.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1,2,5,9,21-24,25,26 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2 and 4 of U.S. Patent No. 5696496. Although the conflicting claims are not identical, they are not patentably distinct from each other because all the limitations in the pending claims are claimed in means format set forth in claim 2 of the patent 5696496. Pending claims 1 and 2 recite a memory means. The

Art Unit: 2635

interpretation for this term is gleaned from the specification page 8 line 19 that states the memory is 512K CMOS RAM (same as claim 2 of the Patent). Claims 1 and 2 recite an audio output means. The interpretation for this term is gleaned from the specification page 9 lines 9+ that specify this element to be a speaker for audio output receiving the output from an audio amplifier (same as claim 2 of the Patent). Claim 2 recites a writing means. The interpretation for this term is gleaned from the specification page 8 lines 24+ that states that this element is a touch panel which will allow input via touching of a display by a stylus that is detachably mounted to the outside of the shell by means such as a bayonet mount (same as claim 2 of the Patent). Claim 4 of the patent sets forth limitations to the portable base station in communication with the handheld device; these limitations correspond to claims 5 and 9 of the application.

4. Claims 6-8 and 10-13 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 4 of U.S. Patent No. 5696496 in view of Mital (5664228). In an analogous art, Mital shows a handheld (shirt pocket sized) device 104 that can be used to store data. The device can be placed in selective engagement with a portable base station 100. The portable base station has a display on a first side and a cradle and keyboard on the second side where the two sides mate together in an open and closed relationship about a hinge. This provides a convenient portable base station that can update synchronize with a handheld device to provide ease in using the system. Therefore, it would have been obvious to one of ordinary skill

Art Unit: 2635

in the art at the time of the invention to have used the portable base station and interface of Mital in the above system in order to provide ease in using the combined system.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greenspan (5459702), Rindfuss (4841387) and Mital (5664228).

Greenspan shows a personal organizer and messaging device (figure 2) that is handheld and can be substantially carried in a shirt pocket as claimed. The device includes an audio input means 56 for receiving and recording an audio message as claimed. The device includes a solid state RAM as the memory means for storing the audio message (see col. 13 lines 42+). The device includes an audio output means to selectively play back the stored audio message(s). The device includes a handheld housing for carrying the above-mentioned means. The device also selectively communicates with a base station.

Art Unit: 2635

In an analogous art, Rindfuss teaches the ability of a playback device to playback stored data (audio data) in a non-sequential manner. Thereby providing improved playback with more flexibility to the user. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have used a playback mechanism as suggested by Rindfuss in order to provide improved access to stored messages in the Greenspan system.

In an analogous art, Mital shows a handheld (shirt pocket sized) device 104 that can be used to store data. The device can be placed in selective engagement with a portable base station 100. The portable base station has a display on a first side and a cradle and keyboard on the second side where the two sides mate together in an open and closed relationship about a hinge. This provides a convenient portable base station that can update synchronize with a handheld device to provide ease in using the system. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have used the portable base station and interface of Mital in the above system in order to provide ease in using the combined system.

6. Claims 9-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maeda (5008854), Yokozawa (4534012) and Mital (5664228).

Maeda shows a handheld device with a touch panel 12 that is written on by a stylus 39. The device includes a solid state RAM 53 for storing data, a microprocessor 31 for recalling the stored data and a display 13 for displaying the recalled data.

In an analogous art, Yokozawa shows a handheld data device 31 that can selectively interface with a base station 32 to synchronize the data stored in both the handheld device and the base station. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have interfaced the handheld device of Maeda to a base station to provide increased processing power for the data stored in the handheld device.

In an analogous art, Mital shows a handheld (shirt pocket sized) device 104 that can be used to store data. The device can be placed in selective engagement with a portable base station 100. The portable base station has a display on a first side and a cradle and keyboard on the second side where the two sides mate together in an open and closed relationship about a hinge. This provides a convenient portable base station that can update synchronize with a handheld device to provide ease in using the system. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have used the portable base station and interface of Mital in the above system in order to provide ease in using the combined system.

7. Claims 14-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maeda (5008854), Yokozawa (4534012) and Mital (5664228) as applied to claim 13 above, and further in view of Vanden Heuvel (5281962).

In an analogous art, Vanden Heuvel shows a handheld shirt pocket sized data storage terminal 110 that interfaces with a portable base station 410. The handheld device includes a wireless communication circuit to receive messages

Art Unit: 2635

over the wireless circuit and store the messages for later recall. The handheld device can interface to the base station in order to transfer those received messages to the base station so the base station can later recall those messages. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have used a wireless communication circuit in the handheld device in order to provide the ability to wirelessly receive messages to the handheld device in an efficient and up to date manner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian A Zimmerman whose telephone number is 703-305-4796. The examiner can normally be reached on Off every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Horabik can be reached on 703-305-4704. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2635

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Brian A Zimmerman
Primary Examiner
Art Unit 2635

BAZ